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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,270	04/14/2004	Ethan D. Sternberg	273012010303	8110

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EXAMINER	
GEMBEH, SHIRLEY V	
ART UNIT	**PAPER NUMBER**
1614	

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/825,270	STERNBERG ET AL.	
	Examiner	Art Unit	
	Shirley V. Gembeh	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 November 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *33-58* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *33-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 33-58 are pending.

Claims 33-58 are rejected.

Claims 1-32 are cancelled.

The amendment to the claims filed November 28, 2005 has been received and entered.

Response to Arguments

Applicant's arguments, see page 6, filed November 28, 2005 with respect to the rejection(s) of claim(s) 33-58 under 103(a) have been fully considered and are persuasive. The rejection of 103(a) has been withdrawn.

Double Patenting

The rejection under statutory double patenting has been dropped.

The rejection under non-statutory double rejection is hereby maintained and repeated.

Nonstatutory Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 33-58 rejected under the judicially created doctrine of double patenting over claim1-32 of U. S. Patent No. 5,929,105 ('105) in view of Matthews et al US 5,041,078. Although the conflicting claims are not identical they are not patentably distinct from each other because the claims of the patent are to a compound that is structurally identical to claimed invention of the patent. The only difference between the patent and the claimed invention is that the compound is used for modulating kinase activity involved in signal transduction.

Signal transduction is any process by which a cell converts one kind of signal or stimulus into another thereby making the claim an obvious variation of the compound. In other to detect activity of the compound light has to be present as taught by Mathews et al., at column 7 lines 60+, where the reference teaches a compound structurally, and functionally similar to the claimed invention of the applicant.

Thus the claims of the application are broader than the patented claims but never the less the current claims are an obvious variation of the patented claims and would

have been obvious to one of ordinary skill in the art to combine the teaching of '105 with that of '078 and successfully achieved the claimed invention of the applicant.

Applicant's arguments have been fully considered but they are not persuasive for the above stated reasons. In response to applicant's argument that the patented claims would not render obvious the instant claims, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Claim 33-58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-24 of U.S. Patent No. 6,153,639. Although the conflicting claims are not identical, they are not patentably distinct from each other. The reasons are as follows:

Both sets of claims refer to the same chemical compound with the same substituents, modulating activity of kinase involved in signal transduction in the current application (claims 33-58) and treating tumors (claims 1-24) in the copending application. The current application claims anticipate the copending application claims because

Both applications recite using the same compositions and/or derivatives thereof. The compositions recited in the claims are anticipatory of each other.

As to the copending application claims 1-24, these claims refer to treating cancer by irradiating said subject with light. As long as the compound is used with light. Signal

transduction would have occurred. Cancer is a process that can take place in virtually any part of the body. There is a vast range of forms that it can take, causes for the problem, and biochemical pathways that mediate the inflammatory reaction. Mediators include signal transduction, protein kinases bradykinin, serotonin, leukotrienes, cytokines, and many, many others. Thus, the process of treating cancer is a set of precursor steps to the producing signal transduction modulated by activity of kinase in the instant claims, and therefore are part of the obvious variation of the copending application claims compared to the current application claims.

In view of the foregoing, the copending application claims and the current application claims are obvious variations.

Response to argument

Pages 7-8 of the response filed 11/28/05 have been considered as to the stated rejections for double patenting. The comments are unpersuasive because the claimed invention is to the same chemical compound, triggering the activity of the compound with light in the instant case as well as in the claimed subject matter in the patented claims. As stated in the MPEP 2112.01 Products of identical chemical composition can not have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Also, "Where the claimed and prior art products are identical or substantially identical in structure or composition, or

are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established.

In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not."

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley V. Gembeh whose telephone number is 571-272-8504. The examiner can normally be reached on 8:30 -5:00, Monday- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SVG
2/17/06

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